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**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

Appeal No. 03-1372

(United States Patent Application Serial No. 09/515,060)

IN RE RAYMOND ANTHONY JOAO

**Appeal from the United States Patent and Trademark Office,
Board of Patent Appeals and Interferences**

BRIEF FOR APPELLANT

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Pro Se Appellant



UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

IN RE RAYMOND ANTHONY JOAO

Appeal No. 03-1372

(United States Patent Application Serial No. 09/515,060)

CERTIFICATE OF INTEREST

Appellant Raymond Anthony Joao, appearing Pro Se, certifies the following:

1. The full name of every party or amicus represented by me is:

Raymond Anthony Joao.

2. The name of the real party in interest represented by me is:

Raymond Anthony Joao.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

None.

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

None.

Date: July 5, 2003


Signature of Pro Se Appellant

RAYMOND A. JOAO
Printed Name of Pro Se Appellant

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

IN RE RAYMOND ANTHONY JOAO

Appeal No. 03-1372

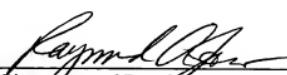
(United States Patent Application Serial No. 09/515,060)

STATEMENT OF RELATED CASES

Appellant Raymond Anthony Joao, appearing Pro Se, certifies the following:

1. No other appeal in or from the proceeding in the United States Patent and Trademark Office Board of Patent Appeals and Interferences was previously before this Court or any other Appellate Court.
2. There is no case known to Appellant Raymond Anthony Joao to be pending in this Court or in any other court that will directly affect or be directly affected by this Court's decision in the pending appeal.

Date: July 5, 2003



Signature of Pro Se Appellant

RAYMOND A. JOAO
Printed Name of Pro Se Appellant

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT
STATEMENT OF JURISDICTION

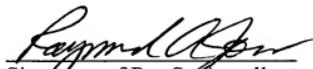
(A) This is an Appeal from the decision of the United States Patent and Trademark Office Board of Patent Appeals and Interferences (the "Board"). The basis for the Board's jurisdiction is 35 U.S.C. §134. The relevant facts establishing the Board's jurisdiction are as follows: The claims in the Appellant Applicant's U.S. Patent Application Serial No. 09/515,060 had been twice rejected, and finally rejected, by the U.S. Patent and Trademark Office. At all relevant times, Appellant Applicant had paid all required fees for the Appeal to the Board.

(B) This Court's jurisdiction to hear this appeal is based upon 28 U.S.C. §1295(a)(4), this being an appeal from a decision of the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office with respect to United States Patent Application Serial No. 09/515,060, at the instance of the Appellant Applicant Raymond Anthony Joao, and this appeal shall waive the right of the Appellant Applicant to proceed under section 145 of Title 35. The facts establishing this Court's jurisdiction to hear this appeal are as follows: The Board of Patent Appeals and Interferences of the United States Patent and Trademark Office affirmed the Examiner's rejection of all pending claims in Appellant Applicant's United States Patent Application Serial No. 09/515,060.

(C) The appeal herein is timely, pursuant to Fed. R. App. P. 4(a)(1)(B) and 28 U.S.C. 2107. The Notice of Appeal was filed on March 26, 2003 which was within sixty (60) days of the January 31, 2003 decision of the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office.

(D) This appeal is from the decision of the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office which affirmed the Examiner's rejection of all pending claims in Appellant Applicant's United States Patent Application Serial No. 09/515,060. This appeal is pursuant to 35 U.S.C. §141 and this Court's jurisdiction is based upon 28 U.S.C. §1295(a)(4).

Date: July 5, 2003



Signature of Pro Se Appellant

RAYMOND A. JOAO
Printed Name of Pro Se Appellant

STATEMENT OF THE ISSUES PRESENTED FOR REVIEW:

A. Whether Claims 1, 2, 4-7, 9, 11, 16-19, 21 and 24-26 of United States Patent Application Serial No. 09/515,060 ("the '060 patent application") are unpatentable under 35 U.S.C. §103(a) over Houstis et al., Internet, Education, and the Web (Houstis) in view of Dunn et al., U.S. Patent No. 5,721,829 (Dunn)?

B. Whether Claim 12 of the '060 patent application is unpatentable under 35 U.S.C. §103(a) over Houstis in view of Dunn and further in view of Dwyer et al., Creating a Virtual Classroom for Interactive Education on the Web (Dwyer)?

C. Whether Claims 13, 14, 22, and 23 of the '060 patent application are unpatentable under 35 U.S.C. §103(a) over Houstis in view of Dunn and further in view of Goldberg, World Wide Web - Course Tool: An Environment for Building WWW - Based Courses (Goldberg)?

D. Whether Claim 15 of the '060 patent application is unpatentable under 35 U.S.C. §103(a) over Houstis in view of Dunn and further in view of Hamalainen et al., Electronic Markets for Learning: Educational Brokerages on the Internet (Hamalainen)?

I. STATEMENT OF THE CASE:

This is an appeal from the decision of the United States Patent and Trademark Office Board of Patent Appeals and Interferences ("the Board"), dated January 31, 2003 (the "Board's decision"), in Appeal No. 2002-0400 in U.S. Patent Application Serial No. 09/515,060 ("the '060 patent application"), which affirmed the Examiner's final rejection of Claims 1, 2, 4-7, 9, 11-19 and 21-26 as set forth in the Examiner's Final Rejection in the Office Action, dated March 28, 2001 ("the Final Action"), and the Examiner's Answer.

The Board rejected Appellant's arguments set forth in the Appellant's Appeal Brief ("the Appeal Brief") and the arguments made by Appellant during oral argument before the Board which took place on January 23, 2003.

In its decision, the Board affirmed the Examiner's rejection of Claims 1, 2, 4-7, 9, 11, 16-19, 21 and 24-26 as being unpatentable under 35 U.S.C. §103(a) over Houstis et al., Internet, Education, and the Web ("Houstis") in view of Dunn et al., U.S. Patent No. 5,721,829 ("Dunn"). The Board also affirmed the Examiner's rejection of Claim 12 as being unpatentable under 35 U.S.C. §103(a) over Houstis in view of Dunn and further in view of Dwyer et al., Creating a Virtual Classroom for Interactive Education on the Web ("Dwyer"). The Board also affirmed the Examiner's rejection of Claims 13, 14, 22, and 23 as being unpatentable under 35 U.S.C. §103(a) over Houstis in view of Dunn and further

in view of Goldberg, World Wide Web - Course Tool: An Environment for Building WWW - Based Courses ("Goldberg"). Lastly, the Board affirmed the Examiner's rejection of Claim 15 as being unpatentable under 35 U.S.C. §103(a) over Houstis in view of Dunn and further in view of Hamalainen et al., Electronic Markets for Learning: Educational Brokerages on the Internet ("Hamalainen").

Appellant takes this appeal from the Board's decision.

II. STATEMENT OF THE FACTS:

The '060 patent application was filed on February 28, 2000 and is a continuation-in-part application of United States Patent Application Serial No. 08/788,387, filed on January 27, 1997, now abandoned. The '060 patent application pertains to an Apparatus and Method For Providing Educational Materials and/or Related Services in a Network Environment, hereinafter referred to as "the present invention". The '060 patent application, as filed, contained twenty Claims numbered 1-20.

A. The Present Invention:

The '060 patent application describes the "Field of the Invention" of the present invention as follows:

"The present invention pertains to an apparatus and a method for providing educational materials and/or related services, and, in particular, the present invention pertains to an apparatus and a method for providing educational materials, instruction, information, and/or related services, for

and/or pertaining to courses of study, training, and/or continuing education courses, to a remote user in a network environment." '060 patent application, at page 2, lines 7-13.

In one exemplary embodiment, the present invention can be utilized to allow an individual to view educational and/or course material, such as a lecture, pursuant to a course or a program of study. Upon terminating a viewing or session, the apparatus and method of the present invention provides for storing information regarding the location in the educational and/or course materials where the session is terminated. A subsequent viewing or session will include a review of at least some of the educational and/or course material presented to the individual in the previous session so as to provide a "review" or "refresher" of previously viewed or presented information.

In another exemplary embodiment, the present invention can be utilized to provide an apparatus and method for allowing an individual to engage in a program or course of study at his or her own pace while having the ability to obtain a review or refresher of a portion of the materials presented from a previous session.

B. The Prosecution of the '060 Patent Application:

In the Office Action, mailed November 16, 2000, the Examiner rejected Claims 2, 3, 10, 18 and 19 under 35 U.S.C. 112, second paragraph. Office Action, mailed November 16, 2000, at page 2. The Examiner also rejected

Claims 1-9, 11, 12 and 15-19 under 35 U.S.C. 103(a) as being unpatentable over Houstis in view of Dunn. Office Action, mailed November 16, 2000, at pages 2-5. The Examiner also rejected Claims 10, 13, 14 and 20 under 35 U.S.C. 103(a) as being unpatentable over Houstis in view of Dunn and further in view of Goldberg. Office Action, mailed November 16, 2000, at pages 5-6.

Appellant filed an Amendment and Response to Office Action, dated February 14, 2001, in which Appellant canceled Claims 3, 8, 10 and 20, added new Claims 21-26, and presented arguments in support of the patentability of all of the pending Claims. Amendment, dated February 14, 2001.

The Examiner issued an Office Action, dated March 28, 2001, which contained a Final Rejection of all of the pending Claims 1, 2, 4-7, 9, 11-19 and 21-26. Office Action, mailed March 28, 2001. The Examiner rejected Claims 1, 2, 4-7, 9, 11, 16-19, 21 and 24-26 under 35 U.S.C. 103(a) as being unpatentable over Houstis in view of Dunn. Office Action, mailed March 28, 2001, at page 4.

In the Office Action, dated March 28, 2001, the Examiner, commenting on Houstis, stated:

"Houstis does not disclose a processing device which one of identifies, records, and stores a first location, wherein said first location is the location in the material where the transmission of the education material terminated, and further wherein a subsequent transmission of said material to the individual commences from a second location which is located before said first location such that at least a portion of the material is re-transmitted to the individual." Office Action, dated March 28, 2001, page 3, lines 3-7.

The Examiner, commenting on Dunn, at page 3, lines 8-15, further stated:

"Dunn discloses a system which one of identifies, records, and stores, a first location, wherein said first location is the location in the material where the transmission of the education material terminated, and further wherein a subsequent transmission of said material to the individual commences from a second location which is located before said first location such that at least a portion of the material is re-transmitted to the individual; wherein the material is marked and a transmitter transmits information regarding the second location to the user; the second location being computed prior to a subsequent transmission, wherein the amount of material re-transmitted is programmably selected (col. 7, line 63 - col. 8, line 11)." Office Action, dated March 28, 2001, page 3, lines 8-15.

The Examiner further stated:

"It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Houstis with the ability to begin a subsequent transmission by retransmitting a portion of the material previously transmitted to the user as disclosed by Dunn. The rationale is as follows: it would have been desirable to enable a user to start and stop the transmission of material, whereby upon the subsequent transmission the user's memory was refreshed by replaying a portion of the material that had been previously transmitted. As Dunn teaches the desirability of retransmitting a portion of the material previously transmitted, one of ordinary skill in the art would have been motivated by Dunn's teaching to provide the remote education system of Houstis with the ability to start and stop a transmission, whereby the start of the subsequent transmission included a portion of the material previously transmitted, thereby refreshing the user's memory." Office Action, dated March 28, 2001, page 3, line 16 to page 4, line 6.

The Examiner also rejected Claim 12 under 35 U.S.C. 103(a) as being unpatentable over Houstis in view of Dunn and further in view of Dwyer, Office Action, mailed March 28, 2001, at pages 4-5, and rejected Claims 13, 14, 22 and 23 under 35 U.S.C. 103(a) as being unpatentable over Houstis in view of Dunn

and further in view of Goldberg. Office Action, mailed March 28, 2001, at pages 5-6. Lastly, the Examiner rejected Claim 15 under 35 U.S.C. 103(a) as being unpatentable over Houstis in view of Dunn and further in view of Hamalainen. Office Action, mailed March 28, 2001, at page 6.

C. Appellant's appeal before the United States Patent and Trademark Office Board of Patent Appeals and Interferences:

Appellant appealed the Examiner's Final Rejection of Claims 1, 2, 4-7, 9, 11-19 and 21-26 to the United States Patent and Trademark Office Board of Patent Appeals and Interferences ("the Board") in Appeal No. 2002-0400. In a decision, mailed January 31, 2003 (the "Board's decision"), the Board affirmed the Examiner's rejection of all of the pending claims in the '060 patent application. Board's decision, at page 14.

In addressing the first stated rejection of Claims 1, 2, 4-7, 9, 11, 16-19, 21 and 24-26, the Board, in pertinent part, stated:

"Initially, we treat the teachings and suggestions of the references individually. As the title reflects, the article by Houstis reflects a distance learning environment facilitated by the use of the Internet or the web, in the context of a university teaching its own students. Significantly, what topic 2 reveals at page 27, column 2 is that it was known to Houstis to utilize a local cable television system with which to present to students videotaped or live lectures being shown on some local cable television channel. This teaching alone compares with the basic cable TV environment of Dunn. Dunn enhances cable television systems by teaching the ability to provide an interactive television system for video-on-demand programs. The interactive nature of the programs in Dunn is compared with the teaching value at the first column at page 28 of Houstis where it is explained that an interactive multimedia nature of his approach

would utilize student controls with the use of point-and-click devices (e.g., a mouse) that allows the student to control 'the flow of the lecture.' This capability alone would appear to us to teach or suggest to the artisan the ability to stop, start or even repeat all or a portion of a given lecture. The same capability exists within Dunn for the user to purchase or repurchase a complete video-on-demand program or, as emphasized by the examiner in the final rejection and answer, the teachings at columns 7 and 8 (particularly those in the paragraph bridging columns 7 and 8) permit the ability to optionally roll back a commercial purchased program so that it may be repeated to refresh the viewer with the sequence of events before the viewer last stopped receiving the broadcast. It is this interactive multimedia nature of both references that the examiner urges, and with which we fully agree, permits the interactive data processing devices of both references to meet or suggest the subject matter at the end of each independent claim on appeal reciting the ability to the user to go to a second location preceding the first stopped location for a retransmission of at least a portion of the educational material already transmitted." Board's decision, at pages 4-5.

The Board also affirmed the Examiner's rejections of the remaining pending Claims 12, 13, 14, 15, 22 and 23.

The Appellant appeals the Board's decision to this Court in the present appeal.

III. SUMMARY OF THE ARGUMENTS:

A. CLAIMS 1, 2, 4-7, 9, 11, 16-19, 21 AND 24-26 ARE PATENTABLE OVER HOUSTIS IN VIEW OF DUNN. THERE IS NO TEACHING OR MOTIVATION TO COMBINE THE TEACHINGS OF HOUSTIS AND DUNN TO RENDER CLAIMS 1, 2, 4-7, 9, 11, 16-19, 21 AND 24-26 UNPATENTABLE. HOUSTIS TEACHES AWAY FROM THE ASSERTED COMBINATION OF HOUSTIS AND DUNN. IN THE ABSENCE OF A TEACHING OR MOTIVATION TO COMBINE THE TEACHINGS OF HOUSTIS AND DUNN, THE EXAMINER AND THE BOARD ERRED BY IMPROPERLY USING HINDSIGHT IN REJECTING CLAIMS 1, 2, 4-7, 9, 11, 16-19, 21 AND 24-26. THE BOARD'S FACTUAL FINDINGS ARE NOT

SUPPORTED BY SUBSTANTIAL EVIDENCE AND, THEREFORE, THE BOARD'S DECISION SHOULD BE REVERSED.

B. CLAIM 12 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN AND FURTHER IN VIEW OF DWYER.

C. CLAIMS 13, 14, 22 AND 23 ARE PATENTABLE OVER HOUSTIS IN VIEW OF DUNN AND FURTHER IN VIEW OF GOLDBERG.

D. CLAIM 15 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN AND FURTHER IN VIEW OF HAMALAINEN.

IV. ARGUMENTS:

A. CLAIMS 1, 2, 4-7, 9, 11, 16-19, 21 AND 24-26 ARE PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

Appellant respectfully submits that Claims 1, 2, 4-7, 9, 11, 16-19, 21 and 24-26 are patentable over Houstis in view of Dunn. In this regard, Appellant respectfully submits that the Board's decision, affirming the Examiner's rejection of Claims 1, 2, 4-7, 9, 11, 16-19, 21 and 24-26, is improper and should be reversed.

The Claims on Appeal are provided in Addendum I attached hereto. Claim 1, which is representative of the subject matter of the independent Claims 1, 16, 18 and 25, is reproduced below:

1. An apparatus for providing educational materials, comprising:
a processing device for processing a request from an individual to receive educational material, wherein said educational material is at least one of video material, audio material, and video and audio material; a memory device for storing said educational material;

a transmitter for transmitting said educational material to the individual in response to said request to receive said educational material, wherein said transmitter is controlled by said processing device; and

a receiver for receiving a transmission termination signal from the individual,

wherein said processing device terminates the transmission of said educational material in response to the termination signal, and further wherein said processing device at least one of identifies, records, and stores, a first location, wherein said first location is the location in said educational material where the transmission of said educational material is terminated, and further wherein a subsequent transmission of said educational material to the individual commences from a second location which is located before said first location in said educational material, and further wherein said subsequent transmission of said educational material includes a transmission of at least a portion of said educational material previously transmitted to the individual.

1. THE APPROPRIATE STANDARD OF REVIEW:

Findings of fact by the United States Patent and Trademark Office Board of Patent Appeals and Interferences must be reviewed under the "substantial evidence" standard of review. In Re Zurko, 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed Cir. 2001).

2. THERE IS NO TEACHING OR MOTIVATION TO COMBINE THE TEACHINGS OF HOUSTIS AND DUNN TO RENDER CLAIMS 1, 2, 4-7, 9, 11, 16-19, 21 AND 24-26 UNPATENTABLE:

There is no teaching or motivation in Houstis or in Dunn to combine their respective teachings so as to render Claims 1, 2, 4-7, 9, 11, 16-19, 21 and 24-26 unpatentable. Such a teaching or motivation is required. In re Dembiczak, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999); In Re Rouffet, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998).

In In Re Dembiczak, this Court stated:

"Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." In re Dembiczak, 175 F.3d at 999, 50 U.S.P.Q.2d at ____.

This Court also stated that "... the showing must be clear and particular."

In re Dembiczak, 175 F.3d at 999, 50 U.S.P.Q.2d at ____.

The Examiner cited Houstis for its teachings relating to providing educational services in a communication network environment. Office Action, dated March 28, 2001, at pages 2-3. Houstis describes an Internet-based or web-based distance education system. The Examiner, recognizing that Houstis fails to disclose or suggest certain of the recited features and limitations of the respective claims, relied upon the teachings of Dunn to supply the missing pieces. Office Action, dated March 28, 2001, at pages 3-4. In this manner, the Examiner improperly attempted to piece together the Appellant's claimed invention, from the teachings of Houstis and Dunn, using Appellant's claims as a blueprint or template. There is no teaching or motivation in Houstis or in Dunn for combining their respective teachings in the manner espoused by the Examiner and adopted by the Board. As such, the Board's rejection of the pending claims should be reversed.

The Internet-based or web-based distance education system described in

Houstis differs radically from cable television-based distance education system technology. Houstis, at page 28. Dunn is directed to a cable television-based system. As expressly recognized by Houstis, the primary reference of the asserted combination, the technologies described by Houstis and Dunn are radically different from one another. Houstis, at page 28.

The Board, in its decision, offered numerous reasons in an attempt to find similarities in the systems described by Houstis and Dunn. Board's decision, at pages 4-8. The Board, however, failed to address the express teachings of Houstis which clearly indicated, and which unequivocally states, that the proposed Houstis system is radically different from prior art distance education systems which include cable television-based systems. Houstis, at pages 27-28. The Board's failure to address these express teachings of Houstis, which served to distinguish the proposed system of Houstis from prior art cable television-based distance education systems, speaks volumes. The Board also failed to address the teachings of Houstis which indicated that cable television-based distance education systems had numerous shortcomings and disadvantages associated therewith. The Board's factual conclusions are simply untenable.

The radical differences between the proposed system of Houstis and the prior art cable television-based systems cannot be ignored. One having ordinary skill in the art of Internet-based or web-based distance education systems, at the

time of Appellant's invention, would not have looked to, and would not have been motivated to look to, cable television-based technology in order to make or utilize Appellant's claimed invention. Internet-based or web-based systems and cable television-based systems are two totally different technologies, as expressly recognized by Houstis, the primary reference upon which the obviousness rejection was based. These differences are further underscored by the teachings of Houstis which discuss the various shortcomings of prior art distance education systems which include cable television-based systems. At the time of Appellant's invention, one having ordinary skill in a newly developing and radically different field such as Internet-based or web-based distance education systems simply would not have looked to, and would not have been motivated to look to, cable television-based system technology in an attempt to make or use innovative Internet-based or web-based distance education systems.

In the absence of such a teaching or motivation to combine the teachings of Houstis and Dunn, the Board's decision, affirming the Examiner's rejection of Claims 1, 2, 4-7, 9, 11, 16-19, 21 and 24-26, is untenable and should be reversed.

3. HOUSTIS TEACHES AWAY FROM THE ASSERTED COMBINATION OF HOUSTIS AND DUNN:

As noted above, there is no teaching or motivation in Houstis or in Dunn for combining their respective teachings in the manner espoused by the Examiner and adopted by the Board. To the contrary, Houstis expressly teaches away from any such combination. Houstis expressly teaches away from, and against, the use of cable television-based distance education technology in providing courses over the Internet and/or the World Wide Web. Houstis, at pages 27-28. Most notably, Houstis states:

"The proposed approach, as will become clear in the following pages, differs radically from the above TV-based traditional ones."
Houstis, at page 28 (emphasis added).

Appellant disagrees with the Board's assertion that:

". . . it was known to Houstis to utilize a local cable television system with which to present to students videotaped or live lectures being shown on some local cable television channel. This teaching alone compares with the basic cable TV environment of Dunn." Board's decision, at page 4.

The Board's selective reliance on only certain portions of text from the Houstis reference is misplaced. To the contrary, the references to cable television-based distance education systems, made in Houstis, are, instead, meant to point out the radical differences between the system proposed in Houstis and the cable television-based distance education systems of the prior art. Houstis' description of the prior art cable television-based distance

education systems merely serve to point out the differences, radical differences by Houstis' own account, which exist between the Internet-based or web-based distance education system proposed in Houstis and the prior art cable television-based distance education systems.

The Board failed to address the express teachings of Houstis which clearly indicated that the technological field of Internet-based or web-based distance education systems is radically different from prior art cable television-based distance education systems. The Board also failed to point to any teaching or motivation which would have served to direct one skilled in the art to ignore the shortcomings and disadvantages of the prior art cable television-based systems and still attempt to look to cable television-based technology to make or use the Appellant's claimed invention.

Thus, Houstis teaches away from the asserted combination with the teachings of Dunn. One skilled in the art would not have been motivated to look to the technological field of cable television-based distance education systems, which "differs radically" from the technological field of Internet-based or web-based distance education systems, to improve upon the teachings of Houstis to arrive at Appellant's claimed invention, especially when Houstis pointed to the deficiencies and shortcomings of prior art cable television-based distance education systems. To the contrary, one skilled in the art would have been led

far away from using cable television-based technology in attempting to make or use Appellant's claimed invention.

Houstis is clear and unequivocal in its teachings. Houstis also provides:

"The existing Global Information Infrastructure with a vast, interconnected network of networks (Internet) and software (e.g. Netscape, Java) that efficiently exploits it, has already impacted many facets of our life. The way we disseminate information, conduct business, manage personal activities, and search for knowledge and information are undergoing profound changes. This technology and its future evolution has the potential of making telelearning the new educational paradigm at local (within a given institution) and global (nationwide, even worldwide) levels. The more cynical readers might detect here an uncomfortable similarity to the failed predictions of the past. Is this prediction going to suffer the same unfortunate fate, or is the situation really 'different this time'? We believe it is indeed different this time, not as an automatic and unavoidable consequence of the info-highway, but rather because of the kinds of vehicles that are yet to be built for traveling the highway."

Houstis, at Page 27 (citations omitted).

Houstis further provides:

"We feel that universities need to understand and appreciate this technology and develop a *Cyberversity* of sorts. Before developing on this theme, we briefly sketch what telelearning means in this context, in particular how it differs from the traditional notion of distance education which uses communications to extend the reach of the lecturer."

Houstis, at Page 27 (emphasis in original).

Houstis further describes the then current practices of distance education along with examples which include the Mind Extension University which "involves video-taped or live lectures being shown on some local cable channel" and the practice by many universities to "offer courses remotely via satellite,

with videos of the lecture available for the students who miss the lecture or want to see it again". Houstis, at pages 27-28.

Houstis clearly distinguishes the cable television-based distance education systems from the Houstis proposed Internet-based or web-based system. Houstis states that "The proposed approach, as will become clear in the following pages, differs radically from the above TV-based traditional ones." Houstis, at page 28 (emphasis added).

Houstis clearly teaches away from using cable television-based distance education technology in the therein proposed Internet-based or web-based distance education system. In this regard, Houstis, the primary reference of the asserted combination, expressly teaches away from combining the teachings of Houstis and Dunn.

4. IN THE ABSENCE OF A TEACHING OR MOTIVATION TO COMBINE THE TEACHINGS OF HOUSTIS AND DUNN, THE EXAMINER AND THE BOARD ERRED BY IMPROPERLY USING HINDSIGHT IN REJECTING CLAIMS 1, 2, 4-7, 9, 11, 16-19, 21 AND 24-26:

In the absence of any teaching or motivation to combine the teachings of Houstis and Dunn, the Examiner and the Board erred by improperly using hindsight to reject Claims 1, 2, 4-7, 9, 11, 16-19, 21 and 24-26.

There is no teaching, motivation, or suggestion, in Houstis, Dunn, or their combination, for combining their respective teachings, in the manner espoused by

the Examiner and adopted by the Board. Instead, the Examiner and the Board used hindsight to combine the teachings of Houstis and Dunn, which is improper and contrary to controlling case law governing obviousness determinations as set forth by this Court. In Re Rouffet, 149 F.3d 1350, 47 U.S.P.Q.2d 1453; In re Dembiczak, 175 F.3d 994, 50 U.S.P.Q.2d 1614.

The Examiner, in relying on Houstis as the primary reference in his obviousness determination, recognized a significant and patentable distinction between the present invention and Houstis. The Examiner indicated that:

"Houstis does not disclose a processing device which one of identifies, records, and stores a first location, wherein said first location is the location in the material where the transmission of the education material terminated, and further wherein a subsequent transmission of said material to the individual commences from a second location which is located before said first location such that at least a portion of the material is retransmitted to the individual." Office Action, dated March 28, 2001, at page 3, lines 3-7.

The Examiner improperly relied upon Dunn in an attempt to supply the missing elements of independent Claims 1, 16, 18 and 25. The Examiner's reasoning in support of his rejection of independent Claims 1, 16, 18 and 25 further supports Appellant's position that the Examiner used hindsight in reaching the asserted obviousness determination.

The Board, in its decision, provided numerous arguments in support of the asserted combination. Board's decision, at pages 4-8. The Examiner and the Board, however, failed to address the "radical differences" between the Houstis

Internet-based or web-based distance education system and the cable television-based distance education systems of the prior art, which radical differences were recognized by Houstis. Further, the Examiner and the Board failed to address Houstis' teachings which, no doubt, would have only directed one skilled in the art away from cable television-based technology. Houstis clearly recognizes the differences between its proposed system and prior art cable television-based systems.

The Examiner erred by looking beyond the teachings of Houstis and Dunn only after using Appellant's independent Claims 1, 16, 18 and 25 as a blueprint or template. In Re Rouffet, 149 F.3d at 1357, 47 U.S.P.Q.2d at ____; In re Dembicza, 175 F.3d at 999, 50 U.S.P.Q.2d at ____.

In view of the foregoing, the Examiner and the Board improperly utilized hindsight in order to piece together the elements of independent Claims 1, 16, 18 and 25 from the teachings of Houstis and Dunn, only after using Appellant's claimed invention, as defined by each of independent Claims 1, 16, 18 and 25, as a blueprint, an approach which is untenable and contrary to law, as espoused by this Court. In Re Rouffet, 149 F.3d 1350, 47 U.S.P.Q.2d 1453.

In In Re Rouffet, this Court stated:

"Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art

corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'" In Re Rouffet, 149 F.3d at 1357, 47 U.S.P.Q.2d at ___ (Fed. Cir. 1998).

In view of the foregoing, Appellant submits that the Examiner's rejection of Claims 1, 2, 4-7, 9, 11, 16-19, 21 and 24-26 and the Board's decision, affirming the Examiner's rejection, constituted the improper use of hindsight.

5. THE BOARD'S FACTUAL FINDINGS ARE NOT SUPPORTED BY SUBSTANTIAL EVIDENCE AND, THEREFORE, THE BOARD'S DECISION SHOULD BE REVERSED:

The Board's factual findings are not supported by substantial evidence and, therefore, the Board's decision should be reversed. In re Haruna, 249 F.3d 1327, 58 U.S.P.Q.2d 1517 (Fed Cir. 2001).

This Court, in In Re Kotzab, stated "The ultimate determination of whether an invention would have been obvious under 35 U.S.C. §103(a) is a legal conclusion based on underlying findings of fact." In Re Kotzab, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, ___ (Fed Cir. 2000). The Board's underlying factual findings should be reviewed to determine if substantial evidence exists to support such findings. In Re Thrift, 298 F.3d 1357, 1363, 63 U.S.P.Q.2d 2002, ___ (Fed Cir. 2002). The Board's factual findings, underlying its ultimate determination of obviousness of the pending claims, are not supported by substantial evidence.

The Board's factual determinations, which included findings of fact relating to the Board's assertion that there was a teaching or motivation to combine the respective teachings of Houstis and Dunn, despite Houstis' express teachings to the contrary, are simply untenable. The Board attempted to draw upon alleged instances of similarities between Houstis and to find some "overlap" between Houstis and Dunn. Board's decision, at pages 4-8. In doing so, the Board failed to address the teachings of Houstis, which described the proposed Houstis system as being "radically different" from prior art systems which included cable television-based systems and which also pointed out deficiencies known to be associated with cable television-based systems. The Board's failure constitutes reversible error. As a result, there is no substantial evidence to support the Board's findings and the Board's conclusion to combine the teachings of Houstis and Dunn to render independent Claims 1, 16, 18 and 25 unpatentable. One having ordinary skill in the art would not have been motivated to combine the teachings of Dunn with the teachings of Houstis to arrive at Appellant's claimed invention. To the contrary, the skilled artisan, guided by Houstis, would never have even looked to Dunn, or to cable television-based technology, in attempting to make or use Appellant's claimed invention.

The prior art itself must establish the obviousness of the combination. In Re Dance, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, ___ (Fed Cir. 1998). Here, the teachings of Houstis and Dunn fail to establish the obviousness of Claims 1, 2, 4-7, 9, 11, 16-19, 21, and 24-26.

6. CLAIMS 1, 2, 4-7, 9, 11, 16-19, 21 AND 24-26 ARE PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

In view of the foregoing, Appellant submits that Claims 1, 2, 4-7, 9, 11, 16-19, 21 and 24-26 are patentable over Houstis in view of Dunn.

a. Independent Claims 1, 16, 18 and 25:

As discussed above, there is no teaching or motivation to combine the teachings of Houstis and Dunn to arrive at the claimed invention, as defined by independent Claims 1, 16, 18 and 25. Claims 1, 16, 18 and 25 are patentable over Houstis in view of Dunn and the Board's decision, affirming the Examiner's rejection of Claims 1, 16, 18 and 25, should be reversed.

b. Claims 2, 4-7, 9, 11, 21, 22 and 24:

Claims 2, 4-7, 9, 11, 21, 22 and 24 depend directly from independent Claim 1 and include all of the features and limitations of said independent Claim. Appellant incorporates by reference herein the above arguments regarding the patentability of Claims 1, 16, 18 and 25 over Houstis and Dunn as if fully restated herein. Each of the respective Claims 2, 4-7, 9, 11, 21, 22 and 24 recite additional features and limitations which serve to further narrow the

scope of the present invention, as defined by independent Claim 1. Claims 2, 4-7, 9, 11, 21, 22 and 24, therefore, are also patentable over Houstis in view of Dunn. The Board's decision, affirming the Examiner's rejection of Claims 2, 4-7, 9, 11, 21, 22 and 24, should be reversed.

c. Claim 17:

Claim 17 depends directly from independent Claim 16 and includes all of the features and limitations of said independent Claim. Appellant incorporates by reference herein the above arguments regarding the patentability of Claims 1, 16, 18 and 25 over Houstis and Dunn as if fully restated herein. Claim 17 recites additional features and limitations which serve to further narrow the scope of the present invention, as defined by independent Claim 16. Claim 17, therefore, is also patentable over Houstis in view of Dunn. The Board's decision, affirming the Examiner's rejection of Claim 17, should be reversed.

d. Claim 19:

Claim 19 depends directly from independent Claim 18 and includes all of the features and limitations of said independent Claim. Appellant incorporates by reference herein the above arguments regarding the patentability of Claims 1, 16, 18 and 25 over Houstis and Dunn as if fully restated herein. Claim 19 recites additional features and limitations which serve to further narrow the scope of the present invention, as defined by independent Claim 18. Claim 19,

therefore, is also patentable over Houstis in view of Dunn. The Board's decision, affirming the Examiner's rejection of Claim 19, should be reversed.

e. Claim 26:

Claim 26 depends directly from independent Claim 25 and includes all of the features and limitations of said independent Claim. Appellant incorporates by reference herein the above arguments regarding the patentability of Claims 1, 16, 18 and 25 over Houstis and Dunn as if fully restated herein. Claim 26 recites additional features and limitations which serve to further narrow the scope of the present invention, as defined by independent Claim 25. Claim 26, therefore, is also patentable over Houstis in view of Dunn. The Board's decision, affirming the Examiner's rejection of Claim 26, should be reversed.

B. CLAIM 12 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN AND FURTHER IN VIEW OF DWYER:

Claim 12 is patentable over Houstis in view of Dunn and further in view of Dwyer. Claim 12 depends directly from dependent Claim 11 which Claim 11 depends directly from independent Claim 1. Appellant incorporates by reference herein the above arguments regarding the patentability of Claims 1, 16, 18 and 25 over Houstis and Dunn as if fully restated herein. There is no teaching or motivation to combine the teachings of Houstis and Dunn to render independent Claim 1 unpatentable. Claim 12 includes all of the features and limitations of independent Claim 1 and dependent Claim 11 and further includes

additional features and limitations. Appellant respectfully submits that the asserted combination of Houstis, Dunn and Dwyer fails to disclose or suggest the apparatus having all of the features and limitations of Claims 1 and 11, wherein at least one of said apparatus and said remote user device further comprise a video recording device for facilitating video conferencing between users of the apparatus, all of which features are recited features of Claim 12. In view of the foregoing, the Board's decision, affirming the Examiner's rejection of Claim 12, should be reversed.

C. CLAIMS 13, 14, 22 AND 23 ARE PATENTABLE OVER HOUSTIS IN VIEW OF DUNN AND FURTHER IN VIEW OF GOLDBERG:

1. CLAIMS 13, 14, AND 22:

a. Claim 13:

Claim 13 is patentable over Houstis in view of Dunn and further in view of Goldberg. Claim 13 depends directly from independent Claim 1. Appellant incorporates by reference herein the above arguments regarding the patentability of Claims 1, 16, 18 and 25 over Houstis and Dunn as if fully restated herein. There is no teaching or motivation to combine the teachings of Houstis and Dunn to render independent Claim 1 unpatentable. Claim 13 includes all of the features and limitations of independent Claim 1 and further includes additional features and limitations. Appellant respectfully submits that the asserted combination of Houstis, Dunn and Goldberg fails to disclose or suggest the

apparatus having all of the features and limitations of independent Claim 1 and which further comprises an input device for entering information concerning an update in the individual's one of status and progression related to said one of a course and a program of study, wherein said processing device processes said information and stored said information in said memory device, all of which features are recited features of Claim 13. In view of the foregoing, the Board's decision, affirming the Examiner's rejection of Claim 13, should be reversed.

b. Claim 14:

Claim 14 is patentable over Houstis in view of Dunn and further in view of Goldberg. Claim 14 depends directly from independent Claim 1. Appellant incorporates by reference herein the above arguments regarding the patentability of Claims 1, 16, 18 and 25 over Houstis and Dunn as if fully restated herein. There is no teaching or motivation to combine the teachings of Houstis and Dunn to render independent Claim 1 unpatentable. Claim 14 includes all of the features and limitations of independent Claim 1 and further includes additional features and limitations. Appellant respectfully submits that the asserted combination of Houstis, Dunn and Goldberg fails to disclose or suggest the apparatus having all of the features and limitations of independent Claim 1, wherein said processing device generates a notification signal containing information regarding at least one a course, a lecture, a program, and an

information update regarding same, and further wherein said transmitter transmits said notification signal to one of the individual, a communication device associated with the individual, and a remote user device associated with the individual, all of which features are recited features of Claim 14. In view of the foregoing, the Board's decision, affirming the Examiner's rejection of Claim 14, should be reversed.

c. Claim 22:

Claim 22 is patentable over Houstis in view of Dunn and further in view of Goldberg. Claim 22 depends directly from independent Claim 1. Appellant incorporates by reference herein the above arguments regarding the patentability of Claims 1, 16, 18 and 25 over Houstis and Dunn as if fully restated herein. There is no teaching or motivation to combine the teachings of Houstis and Dunn to render independent Claim 1 unpatentable. Claim 22 includes all of the features and limitations of independent Claim 1 and further includes additional features and limitations. Appellant respectfully submits that the asserted combination of Houstis, Dunn and Goldberg fails to disclose or suggest the apparatus having all of the features and limitations of independent Claim 1, wherein said processing device at least one of determines whether an individual has progressed through at least one of said educational material, a segment of said educational material, and a portion of said educational material, determines

whether the individual has submitted assignments related to said educational material, and determines whether the individual has taken a required examination, all of which features are recited features of Claim 22. In view of the foregoing, the Board's decision, affirming the Examiner's rejection of Claim 22, should be reversed.

2. Claim 23:

Claim 23 is patentable over Houstis in view of Dunn and further in view of Goldberg. Claim 23 depends directly from independent Claim 18. Appellant incorporates by reference herein the above arguments regarding the patentability of Claims 1, 16, 18 and 25 over Houstis and Dunn as if fully restated herein. There is no teaching or motivation to combine the teachings of Houstis and Dunn to render independent Claim 18 unpatentable. Claim 23 includes all of the features and limitations of independent Claim 18 and further includes additional features and limitations. Appellant respectfully submits that the asserted combination of Houstis, Dunn and Goldberg fails to disclose or suggest the apparatus having all of the features and limitations of independent Claim 18, wherein said processor determines whether an individual has progressed through at least one of said educational material, a segment of said educational material, and portion of said educational material, and further wherein said processor determines whether the individual has at least one of submitted an assignment

related to said educational material and has taken a required examination, and further wherein said processor generates a first signal indicative of at least one of the individual's successful completion of said educational material and the individual's failure to successfully complete said educational material, and further wherein said transmitter transmits said first signal to at least one of the individual, an administrator, an instructor, and a third party, all of which features are recited features of Claim 23. In view of the foregoing, the Board's decision, affirming the Examiner's rejection of Claim 23, should be reversed.

D. CLAIM 15 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN AND FURTHER IN VIEW OF HAMALAINEN:

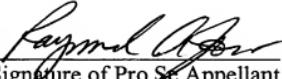
Claim 15 is patentable over Houstis in view of Dunn and further in view of Hamalainen. Claim 15 depends directly from independent Claim 1. Appellant incorporates by reference herein the above arguments regarding the patentability of Claims 1, 16, 18 and 25 over Houstis and Dunn as if fully restated herein. There is no teaching or motivation to combine the teachings of Houstis and Dunn to render independent Claim 1 unpatentable. Claim 15 includes all of the features and limitations of independent Claim 1 and further includes additional features and limitations. Appellant respectfully submits that the asserted combination of Houstis, Dunn and Hamalainen fails to disclose or suggest the apparatus having all of the features and limitations of independent Claim 1, wherein said processing device processes a financial transaction

involving said educational material, all of which features are recited features of Claim 15. In view of the foregoing, the Board's decision, affirming the Examiner's rejection of Claim 15, should be reversed.

V. CONCLUSION AND STATEMENT OF RELIEF SOUGHT:

For the forgoing reasons, the Board's decision, affirming the Examiner's rejection of Claims 1, 2, 4-7, 9, 11-19 and 21-26, is erroneous and is not supported by substantial evidence. The Board's decision should be reversed. Appellant requests that this Court reverse the decision of the United States Patent and Trademark Office Board of Patent Appeals and Interferences and instruct the Commissioner of Patents and Trademarks to grant Appellant a United States Patent for the '060 patent application.

Date: July 5, 2003



Signature of Pro Se Appellant

RAYMOND A. JOAO
Printed Name of Pro Se Appellant

ADDENDUM I

ADDENDUM I: CLAIMS ON APPEAL

1. An apparatus for providing educational materials, comprising:

 a processing device for processing a request from an individual to receive educational material, wherein said educational material is at least one of video material, audio material, and video and audio material;

 a memory device for storing said educational material;

 a transmitter for transmitting said educational material to the individual in response to said request to receive said educational material, wherein said transmitter is controlled by said processing device; and

 a receiver for receiving a transmission termination signal from the individual,

 wherein said processing device terminates the transmission of said educational material in response to the termination signal, and further wherein said processing device at least one of identifies, records, and stores, a first location, wherein said first location is the location in said educational material where the transmission of said educational material is terminated, and further wherein a subsequent transmission of said educational material

to the individual commences from a second location which is located before said first location in said educational material, and further wherein said subsequent transmission of said educational material includes a transmission of at least a portion of said educational material previously transmitted to the individual.

2. The apparatus of claim 1, wherein said education material is at least one of encoded, marked, digitally encoded, analog encoded, digitally marked, analog marked, time-marked, time-stamped, and frame numbered, and further wherein said processing device processes said first location in conjunction with an amount of educational material review to generate said second location.

4. The apparatus of claim 1, wherein said memory device is linked to one of a computer system, a database, a data source, and an educational information source, located external from said apparatus.

5. The apparatus of claim 1, wherein said transmitter transmits one of an announcement, an update, and information, to the individual, wherein said one of an announcement, an update, and information, contains

at least one of educational material, administrative material, testing material, registration material, scheduling material, course material, and program material.

6. The apparatus of claim 1, wherein said transmitter transmits educational material containing at least two of multimedia information, audio information, video information, graphical information, text information, and a live broadcast, simultaneously.

7. The apparatus of claim 1, wherein said processing device computes said second location one of during a current educational session and prior to a subsequent educational session.

9. The apparatus of claim 1, wherein said receiver receives a request from an individual to receive said educational material, and further wherein said processing device identifies said educational material requested.

11. The apparatus of claim 1, further comprising:

a remote user device for receiving said educational material at a location remote from said processing device.

12. The apparatus of claim 11, wherein at least one of said apparatus and said remote user device further comprise:

a video recording device for facilitating video conferencing between users of the apparatus.

13. The apparatus of claim 1, further comprising:
an input device for entering information concerning an update in the individual's one of status and progression related to said one of a course and a program of study,

wherein said processing device processes said information and stored said information in said memory device.

14. The apparatus of claim 1, wherein said processing device generates a notification signal containing information regarding at least one a course, a lecture, a program, and an information update regarding same, and further wherein said transmitter transmits said notification signal to one

of the individual, a communication device associated with the individual, and a remote user device associated with the individual.

15. The apparatus of claim 1, wherein said processing device processes a financial transaction involving said educational material.

16. A method for providing educational materials in a network environment, comprising:

storing educational material;

processing a request from an individual to receive said educational material, wherein said educational material is at least one of video material, audio material, and video and audio material;

transmitting said educational material to the individual in response to said request to receive said educational material;

receiving a transmission termination signal from the individual;

processing said transmission termination signal;

terminating the transmission of said educational material;

at least one of identifying, recording, and storing, a first location, wherein said first location is the location in said educational material where the transmission of said educational material is terminated,

wherein a subsequent transmission of said educational material to the individual commences from a second location which is located before said first location in said educational material, and further wherein said subsequent transmission of said educational material includes a transmission of at least a portion of said educational material previously transmitted to the individual.

17. The method of claim 16, wherein said education material is at least one of encoded, marked, digitally encoded, analog encoded, digitally marked, analog marked, time-marked, time-stamped, and frame numbered, and further wherein said method further comprises:

processing said first location in conjunction with an amount of educational material review to generate said second location.

18. An apparatus for providing educational materials, comprising:

a memory device for storing educational material, wherein said educational material is at least one of video material, audio material, and video and audio material;

a receiver for receiving a request from an individual to receive
 said educational material;
 a processing device for processing said request; and
 a transmitter for transmitting said educational material to the
 individual,

 wherein said receiver receives a transmission termination signal
 from the individual, and wherein said processor processes said transmission
 termination signal and terminates the transmission of said educational
 material, and further wherein said processor at least one of identifies and
 stores a first location in said educational material where said transmission is
 terminated, wherein a subsequent transmission of said educational material
 commences from a second location, wherein said second location is a
 location in said educational material which is located before said first
 location and includes an amount of educational material review during said
 subsequent transmission.

19. The apparatus of claim 18, wherein said processing device
processes said first location in conjunction with an amount of educational
material review to one of determine, compute, and generate said second
location one of subsequent to the termination of a transmission of said

educational material and prior to a subsequent transmission of said educational materials to the individual.

21. The apparatus of claim 1, further comprising:
a transmitter for transmitting information regarding at least one of said first location, an amount of educational material review, and said second location, to the individual.

22. The apparatus of claim 1, wherein said processing device at least one of determines whether an individual has progressed through at least one of said educational material, a segment of said educational material, and a portion of said educational material, determines whether the individual has submitted assignments related to said educational material, and determines whether the individual has taken a required examination.

23. The apparatus of claim 18, wherein said processor determines whether an individual has progressed through at least one of said educational material, a segment of said educational material, and portion of said educational material, and further wherein said processor determines whether the individual has at least one of submitted an assignment related to

said educational material and has taken a required examination, and further wherein said processor generates a first signal indicative of at least one of the individual's successful completion of said educational material and the individual's failure to successfully complete said educational material, and further wherein said transmitter transmits said first signal to at least one of the individual, an administrator, an instructor, and a third party.

24. The apparatus of claim 1, wherein said receiver receives a request from the individual to at least one of re-view and replay at least one of said educational material, a segment of said educational material, and a portion of said educational material.

25. An apparatus for providing educational materials, comprising:

a processing device for processing a request from an individual to receive educational material, wherein said educational material is at least one of video material, audio material, and video and audio material;

a memory device for storing said educational material;

a transmitter for transmitting said educational material to the individual in response to said request to receive said educational material, wherein said transmitter is controlled by said processing device; and

a receiver for receiving a transmission termination signal from the individual,

wherein said processing device terminates the transmission of said educational material in response to the termination signal, and further wherein said processing device at least one of identifies, records, and stores, a first location, wherein said first location is the location in said educational material where the transmission of said educational material is terminated, and further wherein a subsequent transmission of said educational material to the individual commences from a second location which is located before said first location in said educational material, and further wherein said processing device stores information regarding at least one of said first location and said second location in an educational file corresponding to the individual, and further wherein said subsequent transmission of said educational material includes a transmission of an amount of educational material review.

26. The apparatus of claim 25, wherein said amount of educational material review is at least one of programmably selected and selected by at least one of an administrator, an educator, and the individual.

ADDENDUM II

**ADDENDUM II: REPRODUCTION OF RELEVANT
PORTION OF 35 U.S.C. §103**

35 U.S.C. §103 Conditions for patentability; non-obvious subject matter

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

ADDENDUM III

The opinion in support of the decision being entered
today was not written for publication and is
not binding precedent of the Board

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Ex parte RAYMOND ANTHONY JOAO

JAN 31 2003

Appeal No. 2002-0400
Application 09/515,060

PAT & TM OFFICE
BOARD OF PATENTS AND
INTERFERENCES

HEARD: JANUARY 23, 2003

Before THOMAS, KRASS and GROSS, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1, 2, 4-7, 9, 11-19, and 21-26.

Representative claim 1 is reproduced and attached as an appendix to this opinion.

The following references are relied on by the examiner:

Dunn et al. (Dunn) 5,721,829 Feb. 24, 1998

Dwyer et al. (Dwyer), "Creating a Virtual Classroom for Interactive Education on the Web," pgs. 1-9 (WWW'95).

Houstis et al. (Houstis), "Internet, Education, and the Web," Proceedings of WET ICE, pgs. 27-32 (1996).

Goldberg et al. (Goldberg), "World Wide Web - Course Tool: An Environment for Building WWW-Based Courses," Fifth Int'l World Wide Web Conference, pgs. 1-16 (May 1996).

Hamalainen et al. (Hamalainen), "Electronic markets for learning: Education brokerages on the Internet," Communications of the ACM, pgs. 1-9 (June 1996).

Claims 1, 2, 4-7, 9, 11-19, and 21-26 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Houstis in view of Dunn as to claims 1, 2, 4-7, 9, 11, 16-19, 21 and 24-26. To this basic combination of references the examiner adds Dwyer as to claim 12; adds Goldberg as to claims 13, 14, 22 and 23 and adds Hamalainen as to claim 15.

Rather than repeat the positions of the appellant and the examiner, reference is made to the brief for appellant's positions and to the final rejection and answer for the examiner's positions.

OPINION

For the reasons set forth by the examiner in the final rejection and answer, as amplified upon here, we sustain each of the four stated rejections of all the claims on appeal.

At the outset, we note that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of a primary reference. It is also not that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 414, 425, 208 USPQ 871, 881 (CCPA 1981); In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

It is noted by the examiner at page 4 of the answer, the arguments presented in the brief are duplicative for each independent claim, 1, 16, 18 and 25 on appeal as confirmed by appellant during oral hearing. At the outset then we treat the first stated rejection of claims 1, 2, 4-7, 9, 11, 16-19, 21 and 24-26 as being obvious over Houstis in view of Dunn. This rejection includes each independent claim, 1, 16, 18 and 25.

Initially, we treat the teachings and suggestions of the references individually. As the title reflects, the article by Houstis reflects a distance learning environment facilitated by the use of the Internet or the web, in the context of a university teaching its own students. Significantly, what topic 2 reveals at page 27, column 2 is that it was known to Houstis to utilize a local cable television system with which to present to students videotaped or live lectures being shown on some local cable television channel. This teaching alone compares with the basic cable TV environment of Dunn. Dunn enhances cable television systems by teaching the ability to provide an interactive television system for video-on-demand programs. The interactive nature of the programs in Dunn is compared with the teaching value at the first column at page 28 of Houstis where it is explained that an interactive multimedia nature of his approach would utilize student controls with the use of point-and-click devices (e.g., a mouse) that allows the student to control "the flow of the lecture." This capability alone would appear to us to teach or suggest to the artisan the ability to stop, start or even repeat all or a portion of a given lecture. The same capability exists within Dunn for the user to purchase or repurchase a complete video-on-demand program or, as

emphasized by the examiner in the final rejection and answer, the teachings at columns 7 and 8 (particularly those in the paragraph bridging columns 7 and 8) permit the ability to optionally roll back a commercial purchased program so that it may be repeated to refresh the viewer with the sequence of events before the viewer last stopped receiving the broadcast. It is this interactive multimedia nature of both references that the examiner urges, and with which we fully agree, permits the interactive data processing devices of both references to meet or suggest the subject matter at the end of each independent claim on appeal reciting the ability of the user to go to a second location preceeding the first stopped location for a retransmission of at least a portion of the educational material already transmitted.

Appellant does not argue the computerized environment of the front end and student-user environment of Houstis, which also compares with the interactive television system 20 of Figure 1 of Dunn including its headend server 22 in Figure 1 as well as each of the respective set top boxes (STB) 26a otherwise known as the user interface unit shown in Figure 2 of Dunn. To prohibit non-student use of the system in Houstis, column 1, page 29 of this reference contemplates the use of coded or cryptographic protocols. It has been well known that similar types of coding

environments exist for set top boxes of video cable environments. The data structures within the database of Dunn at Figure 4 show respective viewer Id's, which may exist separately even within the same household as taught in Dunn.

Houstis teaches virtual classes running on a class-on-demand server as contemplated at the top of column 1 at page 29 of this reference, where this server would be accessible over the Internet or other kind of network environment. This concept is expanded upon at page 30 to indicate that this server would be considered a multimedia-type server with high bandwidth connectivity between the machines. Note page 30, column 1. Additionally, the future work topic 6 at columns 1 and 2 at page 32 contemplates the use of digital video facilities utilizing a high bandwidth connectivity system such as cable connections within campus buildings of a university. This digital video material would be accessible by the digital video multimedia servers. This is essentially the same architecture which is taught in Dunn.

The discussion at columns 1 and 2 of Dunn indicates that this reference contemplates the use of the ability to sequence or order-on-demand movies, video games, television shows and other video content programs from cable user's homes on their own time

schedule. The nature of the programs is also contemplated to be "those commonly provided in the past by on-line computer services." Column 2, lines 48-49. We do not therefore regard, nor do we believe, that the artisan would have regarded any patentable distinction between the nature of the broadly defined "educational materials" recited in each claim on appeal from that clearly specifically taught in Houstis and that which may be considered by the user as educational material from the content of these noted environments or the nature of the programs taught in the cable environments of both references. Houstis is more explicit as to the nature of the information that is claimed than is Dunn. Depending on the nature of the material downloaded in Dunn, the user and/or artisan would have well-considered the nature of any of the earlier identified programs as educational depending on the subjective user or intent desired.

The bottom of column 4 of Dunn contemplates in Figure 2 that analog to digital and digital to analog converters would have been necessary within the user interface unit or set top box 60 shown in this figure. To an artisan, this obviously would have compared to the nature of the cable environments contemplated within Houstis. This assessment of both references, in addition

to the reasoning advanced by the examiner at pages 2-4 of the final rejection and pages 4-8 of the answer, convinces us that the examiner's rationale for combinability of the teachings and suggestions of both references is well founded, in fact, and is consistent within 35 U.S.C. § 103. We therefore do not agree with appellant's continued urging in the brief that the examiner has exercised prohibited hindsight, that is, looking to his own specification and claims as guidance for the combination of Houstis and Dunn. Our expanded assessment of both references earlier in this opinion confirms that the examiner has merely relied upon evidence clearly available in the prior art even to the point that both references relied upon have significant overlapping and cumulative teachings.

It appears that the issue of analogous art has been raised more forcefully by appellant during earlier prosecution than in the brief. However, we are convinced that the examiner's analysis, such as at pages 8 and 9 of the final rejection and pages 7 and 8 of the answer is proper. There, the examiner properly relied upon existing case law that sets for the proper requirements as to what analogous art is within 35 U.S.C. § 103. We essentially repeat it here.

The test to determine whether the prior art is analogous is: "(1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." In re Clay, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992) (citing In re Deminiski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). Note also the common sense analysis in In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992) as to what fields of endeavor an artisan would reasonably be expected to look for a solution to the problems facing the appellant. We see a similarity of structure and function of the claimed invention with the structure in both Houstis and Dunn. Note In re Ellis, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973), which is relied upon at the end of Clay.

Although the examiner's rationale as to analogous art appears to focus upon Dunn as being in the same field of endeavor as appellant's disclosed invention, an assertion with which we fully agree, our earlier detailed assessment of both Dunn and Houstis clearly would have indicated to the artisan that both

references were in the same field of endeavor as appellant's disclosed and claimed invention to the extent it is broadly recited in the independent claims on appeal and, furthermore, that they were both reasonably pertinent to the problems with which appellant was concerned.

We now turn to dependent claims 2, 4-7, 9, 11, 17, 19, 21, 24, and 26 which all depend from independent claims 1, 16, 18 and 25, all of which have been rejected under the first stated rejection relying upon Houstis in view of Dunn. The examiner has essentially set forth no correlation in the final rejection or answer of the features for each of these dependent claims even though they are specified to have been rejected thereunder. For his part, appellant has merely set forth in the brief an assertion of patentability based upon the respective parent independent claims and only what amounts to a general argument of patentability for each of them respectively. This approach appears to violate Rule 37 CFR § 1.192.

Notwithstanding these deficiencies with respect to both the examiner and the appellant's positions as to all these earlier noted dependent claims, we sustain the rejection of each of them. Our earlier assessment of each of the references has indicated to us that the approach followed by appellant in each of the

respective dependent claims of using the alternative to recite plural alternative recitations alone or in combination with other alternative recitations is taught or suggested within the confines of either or both of the references relied upon to Houstis and Dunn. The digital nature of the environment in Dunn is apparent as is the use of the complementary digital video cable environments contemplated at the end of Houstis. It was known in the art to use clearly analog video information as expressed at column 2 at page 27 of Houstis as well as that which is known for conventional cable systems as in Dunn. Thus, the features of dependent claim 2 are clearly taught by both references. The same may be said of dependent claim 4. The nature of the broadly recited information in the initial portion of dependent claim 5 is clearly taught by both references and Houstis clearly contemplates the use of testing material to test the student's mastery of the educational information. The ability to identify each cable user in Dunn is complemented by the ability contemplated at page 29, column 1 of Houstis of the need to identify registered versus nonregistered students.

As to dependent claim 6, the context of multimedia information is clearly taught in both references. The ability for the student to select the "flow of the lecture" at column 1

at page 28 of Houstis is complemented by the examiner-identified teachings at columns 7 and 8 of Dunn. The discussion at column 6 in addition to the separate memory pointer addressability feature at Figure 4 and discussed at column 8 clearly indicate the processing device essentially performs computational operations to determine the present and/or any previous location for the student for review purposes as in dependent claim 7. Both references teach the subject matter of dependent claim 9. The remote locations of the source and reception of the educational materials of dependent claim 11 is taught by both references. As to the subject matter of dependent claim 17, the features recited here correlate with those discussed earlier with respect to claim 2.

The subject matter of dependent claim 19 compares with our earlier discussion with respect to claim 7. Both references teach the subject matter of dependent claim 21.

As to claim 24, this claim appears to encompass the repetition of the entire subject matter of a whole lecture, for example, as well as any portion thereof, which clearly has been indicated earlier to be within the ambient of the teachings and suggestions of both references. Our discussion of Dunn with respect to claim 7 indicates that the data processing system of

this reference in part has some control over the programmable selection of the amount of material for review as in dependent claim 26, as well as the individual, the latter feature of which is clearly taught by "the flow" teaching identified at column 1 of page 28 of Houstis.

We turn next to the separately stated rejections of various dependent claims. The examiner relies upon Dwyer in combination with Houstis and Dunn to reject dependent claim 12. This rejection is essentially set forth at pages 4 and 5 of the final rejection. For his part, appellant merely argues again patentability as being based upon the arguments presented with respect to its parent independent claim 1 and its intermediate dependent claim 11. Appellant does not argue that Dwyer does not teach the features argued by the examiner to be in this reference nor does the appellant argue that Dwyer is not properly combinable with Houstis and Dunn within 35 U.S.C. § 103. We are, therefore, unpersuaded by appellant of the patentability of dependent claim 12.

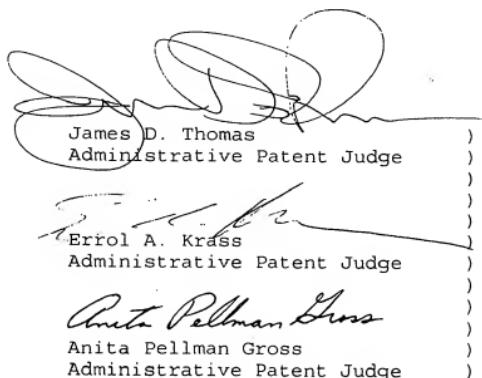
The examiner has separately relied upon Goldberg as additional teachings combinable with Houstis and Dunn within 35 U.S.C. § 103 as to dependent claims 13, 14, 22 and 23 at pages 5 and 6 of the final rejection. Additionally, the examiner has

relied upon Hamalainen as combinable with Houstis and Dunn within 35 U.S.C. § 103 to reject claim 15 at page 6 of the final rejection. Since appellant has followed the same approach with respect to these latter two separately stated rejections, as has been followed by him in the brief as to claim 12, we sustain the rejection of them as well.

In view of the foregoing, the examiner's decision to reject claims 1, 2, 4-7, 9, 11-19, and 21-26 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED



James D. Thomas)
Administrative Patent Judge)
Errol A. Krass)
Administrative Patent Judge)
Anita Pellman Gross)
Administrative Patent Judge)

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APPENDIX

1. An apparatus for providing educational materials, comprising:

a processing device for processing a request from an individual to receive educational material, wherein said educational material is at least one of video material, audio material, and video and audio material;

a memory device for storing said educational material;

a transmitter for transmitting said educational material to the individual in response to said request to receive said educational material, wherein said transmitter is controlled by said processing device; and

a receiver for receiving a transmission termination signal from the individual;

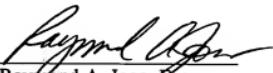
wherein said processing device terminates the transmission of said educational material in response to the termination signal, and further wherein said processing device at least one of identifies, records, and stores, a first location, wherein said first location is the location in said educational material where the transmission of said educational material is terminated, and further wherein a subsequent transmission of said educational material to the individual commences from a second location which is located before said first location in said educational material, and further wherein said subsequent transmission of said educational material includes a transmission of at least a portion of said educational material previously transmitted to the individual.

CERTIFICATE OF SERVICE

CERTIFICATE OF SERVICE

I hereby certify that on July 5, 2003, I caused three copies of the foregoing BRIEF FOR APPELLANT and a letter to be mailed to the Solicitor by United States Postal Service Express Mail Service (next-day delivery, postage prepaid), addressed as follows:

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CERTIFICATE OF COMPLIANCE

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

IN RE RAYMOND ANTHONY JOAO

Appeal No. 03-1372

(United States Patent Application Serial No. 09/515,060)

CERTIFICATE OF COMPLIANCE

Appellant Raymond Anthony Joao, appearing Pro Se, certifies that the number of words in the Brief filed herewith is 7,222 and that the number of words in the ADDENDUM I - CLAIMS ON APPEAL is 1,577, totaling 8,799 words for the combined Brief and ADDENDUM I. Appellant certifies that the 7,222 number of words in the Brief, and that the 8,799 number of words in the combined Brief and ADDENDUM I, are in compliance with the Type-volume limitation set forth in Federal Rule of Appellate Procedure Rule 32(a)(7)(B).

Date: July 5, 2003



Signature of Pro Se Appellant

RAYMOND A. JOAO
Printed Name of Pro Se Appellant